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IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1958.

No. 891

CONTINENTAL GIN COMPANY,
Petitioner,

vs.

THE MURRAY COMPANY OF TEXAS, INC.,
Respondent.

PETITION FOR A WRIT OF CERTIORARI

To the United States Court of Appeals for the Fifth Circuit.

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CONTINENTAL GIN COMPANY,
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THE MURRAY COMPANY OF TEXAS, INC.,
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PETITION FOR A WRIT OF CERTIORARI

To the United States Court of Appeals for the Fifth Circuit.

Your Petitioner, Continental Gin Company, respectfully prays for the issuance of a writ of certiorari to the United States Court of Appeals for the Fifth Circuit to review the judgment of that Court entered on the 26th day of

February, 1959 (petition for rehearing denied April 3, 1959), holding invalid Petitioner's patent No. Re. 23,044. A transcript of the record in the case, including the proceedings in said Court of Appeals, is furnished herewith in accordance with the rules of this Court.

OPINIONS BELOW.

The decision of the Court of Appeals is reported at 120 USPQ 416 and the decision of the District Court at 120 USPQ 427 and said opinions are printed in the Appendix hereto. The order granting the stay of the Mandate of the Court of Appeals until May 13, 1959, is found at page 924 of the certified copy of the record.

JURISDICTION.

The jurisdiction of this Court is invoked under Section 1254 of the Judicial Code (28 U. S. C., Sec. 1254).

QUESTIONS PRESENTED.

1. Should a Court of Appeals disregard findings of fact of a District Court in a patent case where such findings involve a judging of the credibility of witnesses whose testimony on material, highly technical questions such as are here involved is conflicting, and with respect to which testimony the trial court was enlightened by scientific demonstrations; in short, is Rule 52 (a) of the Federal Rules of Civil Procedure applicable to patent cases?

2. Is a Court of Appeals, in deciding the question of invention in a patent case, at liberty to disregard a finding of fact by a District Court to the effect that the subject matter of the patent in suit, taken as a whole, would not have been obvious to a person having knowledge of the

prior art and having ordinary skill in the art to which the patent relates, where such finding of fact is the result of the consideration of the conflicting oral testimony of expert witnesses and of consideration of official published reports of Government experts assigned to work on the problem solved by the patent?

3. May a Court of Appeals reverse a finding of invention by a trial court in a patent case where such finding:

(a) Is based upon all appropriate factual considerations required by the decisions of this Court; and,

(b) Is based upon the application of an exacting standard of invention as required by this Court in the case of **The Great Atlantic & Pacific Tea Company v. Super Market Equipment Corporation, 340 U. S. 147, 152**; and,

(c) Is based upon conflicting testimony of expert witnesses which required the judging of the credibility of such witnesses and as to which the trial court was enlightened by scientific demonstrations?

STATUTES, FEDERAL RULES AND REGULATIONS INVOLVED.

This case involves the following:

Title 35, United States Code, Section 103 (1952):

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this Title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Rule 52 (a) of the Federal Rules of Civil Procedure, in part:

> "(a) Effect. In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of the appropriate judgment; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

SUMMARY AND SHORT STATEMENT OF THE MATTER INVOLVED.

1. Your Petitioner, Continental Gin Company (plaintiff below), is the sole owner of Brooks Patent No. Re. 23,044 relating to apparatus for cleaning lint cotton. The manufacture of lint cleaners of the character covered by the Brooks patent is concentrated in the Fifth Circuit and the patent dominates a substantial portion of the industry. (Affidavit of Mr. Merrill E. Pratt hereto attached.) The problem of cleaning lint cotton as it comes from the gins is one of long standing, is of prime importance to the cotton farmer since it directly affects the price of his cotton, and has been the subject of considerable research. The problem was so pressing and a solution so important that in 1939 the Government of the United States, through the Department of Agriculture, assigned skilled engineers and technicians to find a solution. R. 485 to 497. This work was carried on at the Stoneville Cotton Ginning Laboratory, Stoneville, Mississippi. R. 639. Except for the interruption caused by World War II, the Stoneville Laboratory personnel worked on the problem continuously from 1939 until about 1950. They attempted to adapt mill-type opening room cleaning machinery and Garner regins to the cleaning of lint cotton as it came from the gins. All of these machines and instances of their prior use were relied upon by the defendant as anticipating the patent in suit. None of these experiments were successful. R. 639.

> "Results from the foregoing and numerous other experiments showed that the development of a practical lint cleaner would be difficult." U. S. Department of Agriculture Circular No. 858, R. 639, 642. Gerdes testimony, R. 509, 524, 525.

In 1946, and with full knowledge of the experiments carried on by the U. S. Department of Agriculture at Stoneville, Mississippi, R. 377, and with full knowledge of all the other prior art urged as anticipating the Brooks

patent, defendant itself manufactured a set of lint cleaners and installed them in a gin house in Indianola, Mississippi. R. 120, 379, 417, 418. These machines did not solve the problem and were abandoned at the end of the first ginning season. R. 379. In 1949 the defendant began the manufacture and sale of lint cleaners of a type which had been patented by a Mr. Stedronsky of the Stoneville, Mississippi laboratory. R. 380. These machines did not solve the problem to the satisfaction of the defendant and they abandoned the manufacture of and ceased selling them altogether in 1954. R. 385. Finally, defendant purchased one of plaintiff's commercial machines in 1953, and copied the same and commenced the manufacture and sale of the accused machine in 1955. This solved the problem for the defendant. R. 35 through 47, 96 through 100, 276, 429, 430, finding of fact No. 17, R. 605. Petitioner sells lint cleaners made in accordance with the patent throughout the cotton growing districts of the United States and foreign countries. Up to the time of the trial, more than 4,000 of the said lint cleaners had been sold for approximately $14,000,000.00. The value to the farmers of the lint cotton passing through these machines is increased approximately $20,000,000.00 per year by reason of the removal of trash from the cotton passing through the machines. Finding of fact No. 5, R. 602.

2. Plaintiff instituted suit against respondent (defendant below) charging infringement of claims 3, 4, 5 and 6 of the Brooks patent in the United States District Court for the Northern District of Alabama, Southern Division, because of defendant's manufacture and sale of lint cleaners.

3. Upon the trial in the District Court expert testimony introduced by the parties was in direct conflict which conflicts among others related to the following issues:

(a) Whether the claims of the Brooks patent define a new combination and whether it produces a new result.

(b) Whether the results achieved by the Brooks apparatus are obtainable by any of the prior art apparatus relied upon by the defendant.

(c) Whether the commercial Brooks machine embodies the features described and claimed in the patent.

(d) Whether the apparatus of the Brooks patent amounts to no more than a mere transplanting of the prior art carding engines, pickers, and regins relied upon by the defendant at the trial, to use behind a gin in a gin house.

4. Upon the trial in the District Court the defendant introduced in evidence a number of prior patents. These, together with instances of public use of the Garner regins of the kind experimented with by the Department of Agriculture, were relied upon as anticipating the Brooks patent, or rendering it void for lack of invention. Each of these patents and instances of prior public use were explained in detail to the District Court. There were sharp conflicts in the testimony between the plaintiff's experts as to what these patents and prior apparatus showed and how they operated, and especially as to whether the several apparatus therein shown functioned, or could be made to function, after the manner of the Brooks patent. To illustrate, defendant's Chief Engineer Nitzel, at R. 193 to 245, testified that patents such as Faulkner, Schorsch, Oxley, Howorth, Garner and Washburn disclosed the principles of the Brooks patent. And the written reports of Government experts, published prior to the time this controversy arose, R. 637 to 645, 697 to 701, 705 to 711, and oral testimony by plaintiff's expert witness Francis, R. 549 to 598, and oral testimony by Mr. Leo Gerdes, who was in charge of the U. S. Ginning Laboratory at Stoneville, Mississippi for 25 years, R. 494, 495, 539 to 541, is to the effect that none of these patents or prior apparatus embody the principles of the Brooks patent and that none of them would operate after the manner of the Brooks patented machine. After

considering all this testimony the District Court found that none of the prior apparatus could be made to clean lint cotton behind a gin in a gin house. Findings of fact Nos. 13 and 14, R. 604.

5. In order to aid the District Court to understand the prior art, as well as the apparatus in dispute, various moving and still pictures of the Garner regin, relied upon principally by the defendant to invalidate the Brooks patent, were shown, elaborated upon and commented upon by the defendant's witnesses at the trial. Defendant's exhibits W, R. 231; U, R. 227; V, R. 228, 815 and 816.

6. Before the conclusion of the trial the District Judge, by agreement of the parties, went to the plaintiff's plant, and there, in the presence of all concerned and with on-the-spot explanations by witnesses for both sides, viewed the plaintiff's and the defendant's apparatus in actual side-by-side operation. R. 600.

7. After considering all the conflicting evidence, oral argument, and post-trial briefs, the District Court entered appropriate findings of fact and conclusions of law in which it found, among other things, that the Brooks patent involved invention over the prior art, that the invention was not obvious to a person having ordinary skill in the art to which the subject matter pertains; and that it was valid and infringed. R. 601 to 607.

8. The Court of Appeals, in total disregard of the findings of fact of the District Court, which included specific findings that the Brooks patent measured up to every criterion of "invention" known to the law, held:

> "In sum, the patent in suit does not meet the constitutional requirement of invention. It does not tend 'to promote the Progress of Science and Useful Arts'. U. S. Const., Art. 1, Sec. 8, Cl. 8. Nor does it meet the test of invention required by Congress. 35 U. S. C. 103."

REASONS FOR ALLOWANCE OF THE WRIT AND ARGUMENT.

Rule 52 (a) of the Federal Rules of Civil Procedure, by its terms, applies equally to all civil cases tried before a Court without a jury and this includes patent cases.

While this is a patent infringement suit, the questions submitted for review are not specific to the patent in suit but are general questions of patent law raised by the proceedings and the opinion of the Court of Appeals, showing jurisdiction under Rule 19 (b) of this Court, as follows:

1. The Court of Appeals for the Fifth Circuit has erroneously held invalid a patent which is of the greatest importance to the industry engaged in the raising and processing of cotton and in the manufacture of cotton treating apparatus, which manufacturing industry is concentrated in the Fifth Circuit, whereby litigation elsewhere, with a resulting conflict of decision is improbable. **Schriber Schroth v. Cleveland Trust Co., 305 U. S. 47; Muncie Gear Works v. Outboard Marine & Mfg. Co., 315 U. S. 759. Affidavit, Appendix D.**

2. The Court of Appeals has erred in deciding a Federal Question in a manner conflicting with Rule 52 (a) of the Federal Rules of Civil Procedure; and,

3 The decision of the Court of Appeals is in conflict in important respects with decisions of this Court and the Courts of Appeal of other Circuits on the same question of law; and,

4. The decision of the Court of Appeals that the patent does not meet the test of invention prescribed by Congress in 35 U. S. C. 103 is in violation of FRCP 52 (a) because the District Court found as a fact

that the Brooks invention was not obvious within the meaning of that section of the statute.

5. The decision involves such departure from the accepted and usual course of judicial proceedings as to call for the exercise of this Court's power of supervision. (McCullough v. Cosgrove, 309 U. S. 634.)

As to Point 1.

Following the practice of the **Schriber Schroth v. Cleveland Trust Company** and **Muncie Gear Works v. Outboard Marine and Manufacturing Company** cases, supra, petitioner has included in Appendix D, an affidavit of Mr. Merrill E. Pratt, a person who has intimate knowledge of the cotton industry, to show that manufacture of apparatus of the type in suit is concentrated in the Fifth Circuit.

As to Points 2, 3, 4, and 5.

Traditionally, appellate courts always have given great weight to the findings of fact by trial courts. Even before the adoption of Rule 52 (a), this Court, following the rule then in force, said:

> "Considering that a patent has been granted to the plaintiff, the case is pre-eminently one for the application of the practical rule that so far as the finding of the master or judge who saw the witnesses 'depends upon conflicting testimony, or upon the credibility of witnesses, or so far as there is any testimony consistent with the finding, it must be treated as unassailable'. Davis v. Schwartz, 115 U. S. 631, 636." **Adamson v. Gilliland, 37 S. Ct. 169, 242 U. S. 350, 353.**

After the adoption of Rule 52 (a) the point came before this Court and in its decision, the Court said:

"To no type of case is this last clause more appropriately applicable than to the one before us, where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations. This trial occupied some three weeks, during which, as the record shows, the trial judge visited laboratories with counsel and experts to observe actual demonstrations of welding as taught by the patent and of the welding accused of infringing it, and of various stages of the prior art. He viewed motion pictures of various welding operations and tests and heard many experts and other witnesses. He wrote a careful and succinct opinion and made findings covering all the factual issues.

"The rule requires that an appellate court make allowance for the advantages possessed by the trial court in appraising the significance of conflicting testimony and reverse only 'clearly erroneous' findings." **Graver Tank & Mfg. Co. v. Linde Air Products Co., 1949, 336 U. S. 271, 275, 69 S. Ct. 535, 537.**

The decision of the Court of Appeals in the instant case does not in specific terms set aside the findings of fact of the District Court, but completely ignores them. The statements in the Court of Appeals' decision, purporting to be facts, and upon which its decision is apparently based, are in direct conflict with the specific **findings of fact** of the District Court on the same matters. The proposition we here urge is forcefully expressed in this language:

"It is urged, however, that concurrence of two courts below, in holding the patent claims valid, concludes this Court. A recent restatement of the 'two-court rule' reads, 'A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent find-

ings of fact by two courts below in the absence of a very obvious and exceptional showing of error.' Graver Tank Co. v. Linde Co., 336 U. S. 271, 275 (80 U.S.P.Q. 451, 452). The questions of general importance considered here are not contingent upon resolving conflicting testimony, for the facts are little in dispute. **We set aside no finding of fact as to invention, for none has been made except as to the extension of the counter, which cannot stand as a matter of law. The defect that we find in this judgment is that a standard of invention appears to have been used that is less exacting than that required where a combination is made up entirely of old components. It is on this ground that the judgment below is reversed." Great Atlantic & Pacific Tea Company v. Super Market Equipment Corporation, 340 U. S. 147, 152.** (Emphasis supplied.)

By this language this Court admonishes all appellate courts, including itself, to abide strictly by the principles of Rule 52 (a), not to try cases de novo. In the **A & P Tea** case this Court held as a matter of law that it did not amount to patentable invention merely to make a goods counter longer than it had before been made. That was the sole finding of fact entered by the District Court in that case. It was not ignored nor set aside, but held legally insufficient as the standard of invention applicable to that case. **In the present case the District Court entered findings of fact upon every consideration heretofore accepted as determinative of the proper standard of invention to be applied.** The Court of Appeals did not hold that the findings of fact by the District Court in the instant case were insufficient as a matter of law; instead, the Court of Appeals ignored the trial court's findings and substituted its own judgment on the facts. The record clearly shows that here the Court of Appeals was not in

a position comparable to that of the District Court in finding the facts.

Lastly, the Court of Appeals did not hold the findings of fact by the District Court to be "clearly erroneous". Where, as in this case, there are conflicts in the testimony on vital points, this Court has held that the findings of fact by a District Court should not be set aside by the Court of Appeals as "clearly erroneous."

> "While, of course, it would be our duty to correct clear error, even in findings of fact, the Government has failed to establish any greater grievance here than it might have in any case where the evidence would support a conclusion either way but where the trial court has decided it to weigh more heavily for the defendants. Such a choice between two permissible views of the weight of the evidence is not 'clearly erroneous.'" **U. S. v. Yellow Cab Co., 333 U. S. 338.**

The District Court painstakingly considered and entered findings of fact upon the following all of which have been recognized by this Court as supporting a finding of invention and which, in sum, represent a most exacting standard of invention:

(a) The invention was not obvious to a person of ordinary skill in the art within the meaning of 35 U. S. C., section 103. Finding of fact No. 13; R. 604.

(b) The invention was brought about in 1945 by a need which had existed since 1939 for an efficient means for cleaning lint from mechanically harvested cotton as it came from the gin. Findings of fact Nos. 3, R. 601, and 12, R. 603. **Loom Company v. Higgins, 105 U. S. 580.**

(c) The patented apparatus has enjoyed tremendous commercial success and it is a major improvement and of major benefit to the cotton farmer and the industry

in general. Finding of fact No. 5, R. 602. **Minerals Separation v. Hyde, 242 U. S. 261.**

(d) None of the prior patents and the Garner apparatus relied upon by the defendant were designed by their makers to accomplish the functions of the patent in suit, nor were they adapted or actually used, nor could they be used without modification, to accomplish such functions. Findings of fact Nos. 11, R. 603, and 13, R. 604. **Topliff v. Topliff, 145 U. S. 156.**

(e) The United States Department of Agriculture, employing skilled engineers and technicians in the Stoneville, Mississippi, Ginning Laboratory, commencing in 1939 and continuing after World War II worked on the problem solved by the Brooks apparatus, and in that work a Garner regin and other apparatus urged by defendant to anticipate were tested and found wholly unsuited for the cleaning of lint cotton as it comes from a gin. Finding of fact No. 12, R. 603-604. **Eibel Process v. Minnesota, etc., 261 U. S. 45.**

(f) All of the prior patents relied upon to show lack of invention relate to apparatus different in design and wholly foreign in function to that claimed in the patent in suit. Finding of fact No. 14, R. 604. **Seymour v. Osborne, 78 U. S. 516.**

(g) Prior to placing on the market the apparatus charged to infringe defendant had experimented with at least three different types of lint cleaners. Defendant had purchased plaintiff's machine and had it in its possession when designing the accused apparatus. The accused apparatus is in fact the full equivalent of the patented apparatus. Findings of fact Nos. 15 to 19, inclusive, R. 604, 605. **Adamson v. Gilliland, 242 U. S. 350; Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U. S. 428, 441.**

(h) The claimed combination is a new combination. Finding of fact No. 13, R. 604. **Bates v. Coe, 98 U. S. 31.**

(i) The new combination claimed in the patent produces a new result. Finding of fact No. 5, R. 602. **Loom Company v. Higgins, 105 U. S. 580.**

The standard of invention applied by the District Court in arriving at its determination of validity of the Brooks patent was derived from and based squarely upon the foregoing considerations. Each of these considerations consistently has been held by the courts to be a determination of fact.

In disregarding the foregoing findings of fact by the District Court the Court of Appeals committed three basic errors:

1. It disregarded completely the decisions on the subject by this Court. **Graver Tank & Mfg. Co. v. Linde Air Products Co., ante; The Great Atlantic & Pacific Tea Co. v. Super Market Equipment Corporation, ante; U. S. v. Yellow Cab Co., ante.**

2. It failed to follow the rules laid down by its own prior decisions, both in the fields of general law and patent law.

> "Since their adoption (FRCP), however, all findings of fact, and this includes findings as to damages, made by a trial court on waiver of jury are reviewable in this court, subject to the provisions of rule 52 (a) that 'Findings of fact shall not be set aside unless clearly erroneous.' Under that rule, as it plainly reads and has been interpreted by the courts, it is not for the appellate court to substitute its judgment on disputed issues of fact for that of the trial court where there is

substantial credible evidence to support the finding. Acadian Production Corp. of Louisiana v. Land, 5 Cir., 153 F. 2d 151. It may reverse, though, under the rule (1) where the findings are without substantial evidence to support them; (2) where the court misapprehended the effect of the evidence; and (3) if, though there is evidence which if credible would be substantial, the force and effect of the testimony considered as a whole convinces that the finding is so against the great preponderance of the credible testimony that it does not reflect or represent the truth and right of the case. Katz Underwear v. U. S., 3 Cir., 127 F. 2d 965; McIntosh v. Leisk, 5 Cir., 95 F. 2d 164."

Saunders v. Leech, 158 F. 2d 486, 487. (Hutcheson, C. J.) To the same effect: (a) **Graham v. Jeoffroy, 253 F. 2d 272;** (b) **Bryan, d. b. a. Bryan C[illegible] Lift Equipment v. Garrett Oil Tools Co., Inc., 245 F. 2d 365;** (c) **Inglett & Co., Inc. v. Everglades Fertilizer Co., Inc., 255 F. 2d 342,** and cases cited therein.

3. It failed to follow the great weight of authority as laid down by other Courts of Appeal.

(a) Court of Appeals, First Circuit:

1. **National Development Company v. Lawson-Porter Shoe Machinery Corp., etc., 129 F. 2d 255.**

2. **Emerson et al. v. National Cylinder Gas Company et al., 251 F. 2d 152.**

(b) Court of Appeals, Second Circuit:

Arcadia Knitting Mills, Inc. v. Princeton Knitting Mills, Inc., 124 F. 2d 330 (Cert. Den. 315 U. S. 819).

(c) Court of Appeals, Third Circuit:

Hazeltine Corporation v. General Motors Corporation, 131 F. 2d 34.

(d) Court of Appeals, Fourth Circuit:

1. **S. H. Kress & Company v. Aghnides et al., 246 F. 2d 718.**

2. **Colgate-Palmolive Company et al. v. Carter Products Inc., et al., 230 F. 2d 855.**

(e) Court of Appeals, Sixth Circuit:

1. **O'Leary et al. v. The Liggett Drug Company, etc., 150 F. 2d 656.**

2. **Gibson-Stewart Company, Inc. v. Wm. Bros. Boiler & Mfg. Co., 120 U. S. P. Q. 352** (Decided Feb. 19, 1959).

(f) Court of Appeals, Seventh Circuit:

1. **Miehle Printing Press & Mfg. Co. et al. v. Publication Corporation, 166 F. 2d 615.**

2. **Hyster Company v. Hunt Foods, Inc., et al., 120 U. S. P. Q. 140.**

(g) Court of Appeals, Eighth Circuit:

1. **Keuffel & Esser Company v. Pickett & Eckel, Inc., et al., 182 F. 2d 581.**

2. **Edward F. Higgins v. D. M. Ketterman et al., 257 F. 2d 861.**

(h) Court of Appeals, Ninth Circuit:

Trico Products Corporation v. The Delman Corporation et al., etc., 180 F. 2d 529.

(i) Court of Appeals, Tenth Circuit:

1. **Federal Security Insurance Company v. Smith, 259 F. 2d 294.**

2. **Jones v. Bodaness, 189 F. 2d 838.**

CONCLUSION.

This petition for certiorari should be granted.

Respectfully submitted,

.....

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APPENDIX A.

In the
United States Court of Appeals
For the Fifth Circuit.

No. 17217.

The Murray Company of Texas, Inc.,
Appellant,

versus

Continental Gin Company,
Appellee.

Appeal from the United States District Court for the Northern District of Alabama.

(February 26, 1959.)

Before Cameron and Wisdom, Circuit Judges, and Wright, District Judge.

Wright, District Judge: Plaintiff, appellee here, charges the defendant, appellant here, with infringement of its Brooks patent No. 23,044, issued in 1948, entitled "Cotton Cleaning Apparatus." Appellant, the Murray Company of Texas, interposes the usual defenses of invalidity and non-infringement. The district court, on findings and conclusions prepared and submitted by the prevailing party, held the patent valid and infringed. We hold the Brooks patent invalid for want of invention over the prior art.

The patent covers an apparatus for cleaning lint cotton, which is cotton fiber removed from the seed by ginning. Although the patent indicates that the machine is a general lint cotton cleaner, actually its primary use, as shown in the patent, is in connection with the ginning operation. Cotton which is picked manually ordinarily does not require cleaning between ginning and baling for delivery to the mill. With the advent of mechanical pickers after World War II gin house cleaning became a necessity because of the bits of leaves and other trash picked up by the mechanical picker.

Cotton has long been cleaned at the mill, before being spun into thread, by conventional lint cotton cleaners well known in the art. What the Brooks patent does is simply combine the elements of conventional lint cotton cleaners as found in the mills and place them in a gin house environment. Actually Brooks, the patentee and vice-president of appellee, Continental Gin Company, first applied for a system patent covering the processing of cotton from gin to baling press, passing through a cleaner en route. In the traditional ginning operation before mechanical picking, the cotton was passed from the gin, to a condenser,[1] and thence down a slide to the baler without passing through a cleaner. Brooks was required by the Patent Office to divide his system patent so that the cleaner shown therein, although part of the

[1] In the ordinary ginning operation the lint cotton is airborne through a conduit by the air current of the gin doffing means, from the gin to a condenser, which is a slowly revolving horizontally disposed, cylindrical cage, upon the perforated peripheral surface of which the lint cotton and its carrying current of air are impinged, the air entering the cage through the perforations and being evacuated by suction through the ends of the cylinder, while the lint cotton is deposited and carried around upon the outer surface of the cylinder until it is doffed, or removed, therefrom in a thin continuous bat, or sheet, by the customary pair of driven doffing pinch rollers. The Brooks system patent follows the traditional cotton ginning operation except that a cleaner is placed between the condenser and the baling press.

system, was patented separately. Murray, the accused infringer of the lint cotton cleaning patent, is a licensee under the Brooks system patent. Murray, therefore, has been granted the right to use the system but not the lint cotton cleaner.

The Patent in Suit.

The Brooks patent in suit, the lint cotton cleaner, receives the cotton from a condenser, not part of the patent, down a slide in a wide, thin bat through cylindrical feed rollers which pinch or press the fibers close together. The feed rollers feed the cotton to the periphery of a large rotating cylinder equipped with saw teeth to which the cotton adheres. Centrifugal force presses the heavier trash in the cotton slightly outward, and away from the saw cylinder, where it is struck by the cleaning bars, fixed in place close to the periphery of the rotating saw cylinder, which cars sever the trash from the fiber while keeping the fiber on the cylinder. The trash falls into the lower part of the casing which covers the entire machine. Fiber thrown off by the cleaning bars is blown back to the gin for reworking. The mass of the cotton still adhering to the saw cylinder is taken off, or doffed, by a cylinder equipped with brushes which passes the cotton through a flue and in the direction of the baling press. A wall separates the doffer from the trash compartment, thus preventing trash thrown off the saw cylinder from mixing with the clean cotton. In short, what the Brooks patent in suit shows is the conventional and well-known feed roller the equally conventional and well-known saw cylinder, the traditional doffer, the customary casing with a wall to keep trash separated from the clean cotton, plus a means to convey away the trash.

The claims in suit are 3, 4, 5 and 6. Claim 3 calls for a lint cotton cleaner comprising a relatively wide casing,

a rotating saw cylinder in widely spaced relation with a wall of the casing, feed rollers mounted over the saw cylinder adapted to feeding cotton in a relatively thin uniform bat, a plurality of cleaning bars extending parallel to the axis of the saw cylinder, a conveyer means for disposal of trash, a recovery means for lint thrown off the saw cylinder in the cleaning operation, a doffing means and a wall separating the doffing means from the trash compartment. Claim 4 is generally similar to 3 except that it is not limited to a "plurality of cleaning bars." In other words, claim 4 of the patent covers one cleaning bar. Claims 5 and 6 are similar to 4 except that a single disposal means for trash and lint thrown off the saw cylinder is claimed. In Claims 5 and 6, therefore, the cotton thrown off with the trash would not be recovered.

Brooks, although an officer of a large cotton machinery manufacturer, had no drawings, no plans, no diary, no documents which showed the conception and development of his patent. He testified he conceived the idea sometime in 1944, but there is no evidence of any experimentation pursuant to this conception, nor was any machine, as shown in the patent, ever built. Nor is it shown whether Brooks' conception related to his system which he patented or the cleaner patent in suit. The record does show that Brooks was present at a meeting at Memphis early in 1945 attended by representatives of the cotton industry and that problems attendant on mechanization in the cotton industry were discussed. It was shortly after this meeting that Brooks filed his patent application for a system patent, subsequently divided as above indicated.

The Continental Gin Company, as owner of the patent, on the issue of validity sought to show a long-felt need in the industry for a lint cotton-cleaner, as well as commercial success of its machine. The evidence indicates that in 1946 80% of the cotton in this country was still

picked manually, though it was apparent to the industry, as indicated at the Memphis meeting, that mechanization was on the way. In fact, the Government, before World War II, had made experiments with gin house cleaning, using the lint cotton cleaners then found in the mill. These experiments were not satisfactory although some cleaning was accomplished using the conventional cleaners, particularly the Garner regin.

The machine manufactured by appellee, Continental Gin Company is indeed a commercial success. But the commercial machine is substantially different from the patent. The slide feed to the cleaner from the condenser has been eliminated so that now the feed rollers of the cleaner are fed directly from the condenser doffing rollers. The position of the feed rollers, with respect to the saw cylinder, has been changed and instead of using two smooth feed rollers, as shown in the patent, one is now serrated. In addition, a control bar has been added which keeps the cotton from flaring away and being thrown off the saw cylinder, thus eliminating excessive throw-off of cotton and the necessity for the cotton recovery means shown in the patent. The drawing out, or stretching, of the bat between the condenser doffing rolls and the feed rolls, now an important part of defendant's commercial machine, is nowhere taught in the patent. In fact, a cleaner as shown in the patent has never been manufactured commercially by Continental.

It is common ground that the elements in the Brooks patent present nothing new. Each of them has been in the public domain for many years. Continental contends, however, that its combination is new, that its machine achieves a new result, that this new combination and new result were not obvious to one having ordinary skill in the art. Murray, defendant-appellant, argues that the Brooks combination is but an aggregation of old elements perform-

ing the same function in the same way, that Brooks contributed nothing to the sum of useful knowledge in the cotton cleaning art, and that to give him and his employer a monopoly in the cotton cleaning art would take from the public that which it has long known and used.

The Prior Art.

The prior art discloses many cotton cleaners having the same combination of elements shown in Brooks: feeding means, a rotating saw or toothed cylinder with an ample casing, one or more cleaning or whipping bars, and doffing means. Some of these prior art cleaners also include trash disposals together with a protective wall to separate the clean cotton from the mixed trash and lint. In 1882 the Faulkner patent[2] was issued. It provides for feed rollers, rotating saw cylinder, cleaning bars and doffing means, all very similar in organization and operation to the combination shown in Brooks. Faulkner was not cited by the Patent Office during the prosecution of the Brooks application.

The Schorsch patent[3] issued in 1932 shows a machine for cleaning lint cotton preparatory to spinning. In Schorsch, the cotton is received from a condenser, as in Brooks, in the form of a "bat or fleece" and is fed to the conventional rotating saw or toothed cylinder by a conventional feeding means, this time a feeder roller and plate. The cotton is whipped against cleaning bars, as in Brooks, and is doffed by a doffing brush, also as in Brooks. In fact, the only feature in Brooks absent in Schorsch is a specific means for removing from the bottom of the casing lint and trash thrown off in the cleaning operation. Schorsch was not cited by the Patent Office.

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[2] Faulkner Patent No. 258,397.

[3] Schorsch Patent No. 1,889,615.

In Oxley,[4] issued in 1925, there is shown a lint cotton cleaner in which cotton passes from a condenser to the toothed cylinder of the cleaner by means of feed roller and plate. The cotton is whipped around against cleaning bars, called knives in the patent, and the clean cotton is doffed by a carding drum which arranges the fibers in parallelism for spinning. As with Schorsch and Brooks, lint cotton fed to the rotating cylinder comes directly from the doffing rollers of a condenser in the form of a thin, uniform bat. Oxley also has means to convey away trash plus a wall separating the trash from the clean cotton. Oxley was not cited by the Patent Office.

In 1919 the Howorth patent,[5] cited by the Patent Office, was issued. It is designed to clean and salvage cotton thrown off with trash in the picker operation. Like Brooks, it includes a feeding means closely adjacent to the toothed cylinder and adapted to feed a bat from a condenser to the cylinder, cleaning bars in the customary position close to the cylinder, doffing means and separating wall. Howorth also provides a belt for conveying away "sand or other similar impurities," indicating that means for conveying away trash was not unknown to the art. Other patents of cotton mill cleaners showing most, if not all, of the elements of Brooks are Thoma No. 1,559,475 of 1925 and Hollerung No. 2,238,055 of 1941.

In addition to the cotton mill cleaners anticipating Brooks, there is a series of regin patents covering cleaners designed for cleaning lint cotton in damaged bales. No regin patents were cited by the Patent Office. The Pettit Patent No. 1,401,439 of 1921 shows a cleaner of the regin type. It includes a conventional means for feeding cotton to a rotating saw cylinder within a casing together with

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[4] Oxley Patent No. 1,567,541.

[5] Howorth Patent No. 1,299,185.

cleaning bars, all as in Brooks. Doffing from the saw cylinder is accomplished by an air blast, a means well known in the art. There was also shown in Pettit a trash removal means.

The series of Garner regin patents is also important in the prior art. In 1926 Garner No. 1,574,344 was issued. It shows a rotating toothed cylinder being fed a "bat" of lint cotton by feed rollers. A cleaning brush, together with an air blast for doffing, is also shown. Cotton thrown off by the cleaning brush is recirculated for further cleaning and separate disposal means for removing trash is provided. Garner No. 1,527,859, issued in 1925, shows a brush doffer protected by a wall, recirculation means for thrown off lint and removal means for trash. These early Garner patents show everything of substance disclosed and claimed by Brooks, except one or more cleaning bars for which they substitute a cleaning brush. Beginning in the early 1930's Garner made and sold commercially regins for cleaning cotton from dirty or damaged bales. In these cleaners the cleaning bar, as in Brooks, is used.

The Garner commercial regin includes feed rolls feeding to a saw cylinder, cleaning bar, doffing means, means for recirculating and means for disposal of trash. It was this machine which the Government tested in 1941 while experimenting with gin house cleaning of mechanically picked cotton. In the experiment this machine did clean cotton but it had two drawbacks: excessive throw-off of fiber and insufficient capacity[6] for use with a gin. The excessive throw-off apparently was a result of using only one cleaning bar, thus allowing cotton to flare out from the saw cylinder before it reached the doffing means. Its lack of capacity was attributable to its size. The

[6] All of the prior art mill cleaners and regins were of insufficient capacity for use behind a gin. But as will be shown infra, mere enlargement is not invention.

Garner commercial regin also called for the delivery of the cotton to the feed rolls of the cleaner in a continuous bat. Thus the Garner commercial regin includes every element of Brooks operating in the same way as Brooks.

Validity.

The presumption of validity attends the grant of a patent and the burden of persuasion of invalidity is on the putative infringer. **Radio Corporation of America v. Radio Engineering Laboratories, Inc.**, 293 U. S. 1; 35 U. S. C. § 282. The presumption is strengthened when it appears that the Patent Office has considered and distinguished the prior art relied on as anticipation. **Southern States Equip. Corp. v. USCO Power Equip. Corp.**, 5 Cir., 209 F. 2d 111. But where, as here, the Patent Office has failed to consider pertinent art, the statutory presumption of validity is greatly weakened.[7]

To be patentable, it is not necessary that the machine be broadly or generically new. It is sufficient if its novelty is but an improvement on a prior patent, in which event patent rights thereunder are strictly limited to its precise form and elements. **Diamond Rubber Co. of New York v. Consolidated Rubber Tire Co.**, 220 U. S. 428; 35 U. S. C. § 101. A machine composed of elements of the prior art is patentable if the combination produces a new and useful result. **Leeds & Catlin v. Victor Talking Machine Co.**, 213 U. S. 301; **Jeoffroy Mfg. v. Graham**, 5 Cir., 219 F. 2d 511. But a mere aggregation of old elements performing no new functions and achieving no new result is not patentable. **Lincoln Engineering Co. v.**

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[7] In *Rosaire v. Baroid Sales Division, National Lead Co.*, 5 Cir., 218 F. 2d 72, 75, this Court said: "This article was not considered by the Patent Office and the patents were therefore greatly weakened and they lack the presumption of validity that would otherwise exist." See also *Jacuzzi Bros. v. Berkeley Pump Co.*, 9 Cir., 191 F. 2d 632, 634.

Stewart-Warner Corp., 303 U. S. 545; **Keystone Driller Co. v. Northwest Engineering Corp.**, 294 U. S. 42, 50; **Powers-Kennedy Contracting Corp. v. Concrete Mixing and Conveying Co.**, 282 U. S. 175, 186. As stated by the Supreme Court in **Great Atlantic & Pacific Tea Company v. Supermarket Equipment Corp.**, 340 U. S. 147, 152, "A patent for a combination which only unites old elements with no change in their respective functions, such as is presented here, obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men. This patentee has added nothing to the total stock of knowledge, but has merely brought together segments of prior art and claims them in congregation as a monopoly."

Tested by the teachings of these authorities, it is obvious that the patent in suit is invalid for want of invention over the prior art. Brooks did nothing more than take well-known elements of cotton mill cleaners and place them in a gin house behind a gin without changing their function and without producing a new result. The idea of placing a cleaner behind a gin was a good one but it was not new. It was disclosed in the Washburn patent[8] in 1911. Even if it were new, its application would not amount to invention, but merely to double use, since applying an idea from an analogous art is not invention. **Powers-Kennedy Contracting Corp. v. Concrete Mixing and Conveying Co.**, supra; **Lovell Manufacturing Co. v. Cary**, 147 U. S. 623, 639; **Howe Machine Co. v. National Needle Company**, 134 U. S. 388, 397; **Carbide & Carbon Chemicals Corp. v. Texas Co.**, 5 Cir., 31 F. 2d 32, 33. Nor can invention inhere in mere increased size and capacity because "mere enlargement is not invention." **Planing-Machine Company v. Keith**, 101 U. S. 479, 490; **Pennington v. National Supply Co.**, 5 Cir., 95 F. 2d 291, 295.

[8] Washburn Patent No. 995,993.

In sum, the patent in suit does not meet the constitutional requirement of invention. It does not tend "to promote the Progress of Science and useful Arts." U. S. Const., art. 1, § 8, cl. 8. Nor does it meet the test of invention required by Congress. 35 U. S. C. § 103.[9] What Brooks, and his employer, the Continental Gin Company, did simply was "to watch the advancing wave of improvement" and attempt to "gather its foam in the form of patented monopolies" which would enable them "to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts." **Atlantic Works v. Brady**, 107 U. S. 192, 200.

Reversed.

A true copy.

Test:

Edward W. Wadsworth,
Clerk, U. S. Court of Appeals,
Fifth Circuit,
New Orleans, Louisiana.

(Seal)

April 14, 1959.

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[9] See also *Stabler v. Bright Leaf Industries, Inc.*, 5 Cir., 261 F. 2d 383.

APPENDIX B.

Judgment.

Extract from the Minutes of February 26, 1959.

The Murray Company of Texas, Inc.,
No. 17,217. versus
Continuental Gin Company.

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Alabama, and was argued by counsel;

On Consideration Whereof, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be, and the same is hereby, reversed;

It is further ordered and adjudged that the appellee, Continental Gin Company, be condemned to pay the costs of this cause in this Court for which execution may be issued out of the said District Court.

APPENDIX C.

In the United States District Court for the Northern District of Alabama, Southern Division.

Continental Gin Company, Plaintiff, vs. The Murray Company of Texas, Inc., Defendant.	Civil Action. No. 8061.

Findings of Fact and Conclusions of Law.

This cause coming on to be heard on the testimony and exhibits of plaintiff's and defendant's witnesses and on the argument and briefs of plaintiff's and defendant's counsel, and the Court, being fully advised, finds as follows:

Findings of Fact.

1. This is a suit for infringement of letters patent of the United States No. Re 23,044. The Court has jurisdiction of the cause of action and of the parties.

2. Letters Patent No. Re 23,044, the patent in suit, relates to a lint cotton cleaner and is the property of the plaintiff, Continental Gin Company.

3. The invention of the patent in suit was brought about by the need in the cotton-ginning industry for an efficient means for cleaning the lint from mechanically harvested cotton as it came from the cotton gin and before it was baled.

4. Prior to the invention of the letters patent in suit there was no apparatus on the market available to ginners capable of cleaning lint cotton as it comes from the gin and before it is baled, and the precleaning of seed cotton before being ginned had proceeded as far as was economical.

5. The apparatus disclosed and claimed in the letters patent in suit was first put on the market during the 1948 ginning season, and since that date more than 4,000 machines covered by the patent have been sold for approximately $14,000,000.00. The value of the lint cotton passing through these machines is increased approximately $20,000,000.00 per year by reason of the improved sample produced by the machine.

6. The patent which resulted in the letters patent in suit was filed originally June 7, 1945, and was directed not only to the cotton-cleaning apparatus, but to its combination with the cotton gins, condensers and cotton press found in a gin house. Under the rules of the patent office, the applicant, Eugene H. Brooks, was required to divide the application and file a separate application directed specifically to the lint cotton cleaner.

7. The original application issued as patent No. 2,418,694, April 8, 1947, consisted of two claims directed to a battery of gins, a lint cotton cleaner with each gin, a condenser with each gin adapted to receive lint cotton therefrom and deliver it to its associated lint cleaner, a lint flue common to all gins and cleaners, and means (a valve located in the lint flue) to divert cotton from the gins to the lint flue or to the separate condensers and cleaners. The defendant here is a licensee under that patent, but is not licensed under the patent in suit.

8. The patent upon which this suit is based, issued originally as No. 2,440,139, April 20, 1948, with five claims. After it was issued it was surrendered and an application was filed for a reissue which resulted in the patent in suit No. Re 23044 with six claims.

9. The drawings and description of the apparatus in the patent in suit are in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make

and use the device, and sets forth the best mode contemplated by the inventor of carrying out his invention (35 U. S. C., § 112).

10. The complaint originally charged the defendant with infringement of claims 5 and 6. By amendment to the complaint, the defendant was charged additionally with infringing claims 3 and 4.

11. The defendant relies upon Petit Patent No. 1,401,439, Garner Patents Nos. 1,527,859 and 1,574,344, all relating to regins, and on the patent to Oxley, No. 1,569,541, as anticipating the patent in suit. It also relies upon a stipulated drawing showing a Garner regin as commercially used prior to plaintiff's patent. None of the apparatus shown in these patents or in the stipulated drawing was designed by its maker to accomplish the functions of the patent in suit, nor was it adapted or actually used for the performance of such functions. The defendant also relies upon ten other prior patents as evidence to show that no invention was involved in making the lint cleaner shown in the patent in suit.

12. The United States Department of Agriculture, in 1930, under the authority of U. S. C., Title 7, § 424, established a laboratory at Stoneville, Mississippi, to investigate the ginning of cotton. Skilled engineers and technicians at that laboratory, in an effort to design a lint cotton cleaner, made tests and experiments during the years 1939 to 1941 and following the end of World War II, of available lint-treating apparatus, including a Garner regin, such as is shown in the stipulated drawing of a Garner regin, and found such apparatus, as well as other available apparatus tested, wholly unsuited for cleaning lint cotton as it comes from a gin.

13. None of the apparatus disclosed in the prior patents and instances of prior public use relied upon by the defendant as anticipating the patent in suit, No. Re 23044,

include or show the combination of elements defined in claims 3, 4, 5 and 6 thereof when construed in connection with the specifications to which they relate, and none of the apparatus disclosed in said prior patents and instances or [of] prior public use were designed by their maker, nor were adapted, or actually used for the performance of the functions performed by the apparatus of the patent in suit.

14. The prior patents relied upon by the defendant to show lack of invention in the patent in suit show apparatus which differ in design and are entirely foreign in function to that described and claimed in the patent in suit, No. Re 23044, and the subject matter of said patent in suit, taken as a whole, would not have been obvious to a person having knowledge of said prior patents, and having ordinary skill in the art to which the patent in suit relates.

15. Defendant's engineers, prior to placing the apparatus here charged to infringe on the market, designed and placed on the market three different designs of lint cleaners.

16. During 1953 defendant purchased a lint cleaner from plaintiff which was constructed substantially according to the patent in suit and defendant's engineers had this apparatus in their possession when they designed the apparatus here charged to infringe.

17. Defendant's apparatus here charged to infringe the patent in suit with colorable variations only is clearly similar in design to plaintiff's commercial apparatus, which is built in substantial compliance with the patent in suit, and operates in substantially the same way to produce substantially the same result.

18. In plaintiff's commercial machine, and as described in the patent in suit, No. Re 23044, there are two feed rolls mounted over and closely adjacent to the saw cylinder which feed rolls received the bat of cotton from the con-

denser doffing roll and feed it to the said cylinder. In defendant's machine the condenser is placed nearer to the said cylinder and a single cloth-covered feed roll cooperates with the condenser doffing rolls to feed cotton to the saw cylinder.

19. The means employed by the defendant to feed lint cotton to the saw cylinder of its lint cleaner here charged with infringement functions in substantially the same way to accomplish substantially the same result as the feeding means disclosed and claimed in the patent in suit and is the mechanical equivalent of said means.

20. In plaintiff's apparatus, as first designed, separate means were provided for collecting heavy trash and lint thrown off from the saw cylinder, and it was so described and shown in the Patent No. Re. 23044. It was soon found that an insignificant amount of lint was thrown off in the operation of the machine, and that said separate means for collecting lint served no useful function, thereupon the lint and trash collecting means were combined and the lint and trash were carried away by a single conveyor. Both plaintiff's and defendant's commercial machines now have only a single conveyor for carrying away lint and trash which functions in a manner which is the mechanical equivalent of that shown in the patent in suit.

21. All the essential features of plaintiff's commercial machine are clearly disclosed in the specification and drawings in plaintiff's patent here in suit, No. Re. 23044.

Conclusions of Law.

1. United States Letters Patent No. Re. 23044, the patent in suit, is good and valid in law and is the property of the plaintiff, Continental Gin Company.

2. The defendant, The Murray Company of Texas, Inc., has infringed said letters patent, particularly claims 3, 4, 5 and 6 thereof.

3. Defendant's apparatus is a substantial copy of plaintiff's commercial lint cleaner covered by said letters patent.

4. If it be assumed that defendant's cloth covered feed roller be an improvement over the feed rollers disclosed in the patent in suit, still it does not avoid infringement because it operates in substantially the same way to obtain substantially the same result. (**Temco Electric Motor Co. v. Apco Mfg. Co.**, 275 U. S. 319, 328.)

5. None of the devices and apparatus shown in the prior patents and instances of prior public use relied upon by the defendant as anticipating the patent in suit, No. Re. 23044, and as showing lack of invention in the patent in suit would have, at the time the invention was made, suggested the improvements described and claimed in the patent in suit to a person having ordinary skill in the art to which the subject matter of the patent pertains. The patent accordingly discloses and claims a patentable invention.

6. Pending an accounting, and under the authority of **E-I-M Company, Inc. v. Philadelphia Gear Works, Inc.**, 5 Cir., 223 F. 2d 36, the Court withholds a determination as to whether the infringement has been willful and deliberate and whether a punitive award is justified under Title 35, U. S. C. A., § 285. The Court also withholds a determination of the allowance of reasonable attorneys' fees under Section 286. Jurisdiction as to both matters is specifically reserved.

7. Counsel for plaintiff will submit an appropriate form of judgment for the Court's consideration.

Dated, this the 3rd day of March, 1958.

H. H. Grooms,
United States District Judge.

In the United States District Court for the Northern District of Alabama, Southern Division.

Continental Gin Company;	Plaintiff,	Civil Action. No. 8061.
vs.		
The Murray Company of Texas, Inc.,	Defendant.	

Judgment.

Pursuant to the Findings of Fact and Conclusions of Law entered herein on the 3rd day of March, 1958, it is hereby Ordered, Adjudged and Decreed by the Court as follows:

1. That the patent in suit No. Re 23,044 issued October 19, 1948, for Cotton Cleaning Apparatus is valid.

2. That the lint cotton cleaners heretofore manufactured and sold by the defendant and complained of in the complaint constitute infringements upon said patent, particularly claims 3, 4, 5 and 6 thereof.

3. That the defendant, The Murray Company of Texas, Inc., its officers, employees, and agents, and all those in active concert or participating with them, and each and every one of them be and the same are hereby enjoined from making, using, or selling, directly or indirectly, lint cotton cleaners of the kind described in plaintiff's Exhibits Nos. 2, 3, 6 and 7, or any other that would infringe upon said patent No. Re 23,044.

4. That the matter of damages, attorney's fees, and the question of punitive damages abide an accounting and the Court specifically reserves jurisdiction as to said matters.

5. That the plaintiff have judgment against the defendant for the costs of this action.

Done and Ordered, this the 19th day of March, 1958.

H. H. Grooms,
United States District Judge.

APPENDIX D.

Affidavit in Support of Petition for Certiorari.

State of Alabama
County of Jefferson } ss.

Merrill E. Pratt, being duly sworn, deposes and says that he is of legal age, and that he is the Chairman of the Board of Directors of Petitioner, Continental Gin Company;

That he knows the names and addresses of the various manufacturers of lint cotton cleaning machinery sold in competition with the lint cotton cleaner sold by his company; and that the entire industry is concentrated in the States of Georgia, Alabama, Louisiana and Texas, all within the Fifth Judicial Circuit of the United States.

Merrill E. Pratt.

Sworn to and subscribed before me this 28 day of April, 1959.

H. P. Gaines,
(Seal) Notary Public.

My commission expires January 6, 1960.

Table of Authorities Cited.

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Schriber-Schroth Co. v. Cleveland Trust Co., 305 U.S. 47 8

STATUTES, ETC.

Federal Rules of Civil Procedure, Rule 52(a) 3*n.*, 4

Supreme Court of the United States.

OCTOBER TERM, 1958.

No. 891.

CONTINENTAL GIN COMPANY,
Petitioner,

v.

THE MURRAY COMPANY OF TEXAS, INC.,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI.

This is an ordinary patent suit involving no conflict of decisions between different Courts of Appeals, no new or doubtful question of law, no conflict between the decision of the Court of Appeals and the applicable decisions of this Court or any other court, and no matter of public interest or importance.

Judge Grooms of the District Court, in this his first patent case, held the Brooks patent in suit valid and infringed, "on findings and conclusions prepared and submitted by the prevailing party" (Pet. p. 19), but without opinion. The Court of Appeals, in a careful opinion, analyzed the prior art and on the basis of the facts as to that art, not in dispute, held the Brooks patent in suit invalid for want of invention over the prior art. The appellate court did not pass on infringement.

The Court of Appeals analyzed the primary facts on which it based its conclusion of invalidity at some length—these primary facts comprising the operation and organization of the machine shown and described in the Brooks patent itself and the construction and operation of prior art lint cotton cleaners, as disclosed in prior patents and by a prior art Garner machine. As the appellate court stated (Pet. p. 24), and as petitioner does not deny: "The prior art discloses many cotton cleaners having the same combination of elements shown in Brooks: feeding means, a rotating saw or toothed cylinder with an ample casing, one or more cleaning or whipping bars, and dofling means. Some of these prior art cleaners also include trash disposals together with a protective wall to separate the clean cotton from the mixed trash and lint." All that Brooks had done was to "take well known elements of cotton mill cleaners and place them in a gin house behind a gin without changing their function and without producing a new result." (Pet. p. 28).

After citing the established principles and controlling standards applicable to these undisputed facts, the appellate court concluded (Pet. p. 28): "Tested by the teachings of these authorities, it is obvious that the patent in suit is invalid for want of invention over the prior art."

Thus the Court of Appeals, after a careful analysis of the undisputed facts of the claimed combination and the prior art, disagreed with the District Court's conclusion on the question of invention. That is all there is to this case.

The lower court in its findings nowhere analyzed the prior art and nowhere stated or attempted to state what the alleged invention of the Brooks patent was and wherein resided any patentable novelty in the cleaner of that patent. Nor does the petitioner now venture to identify the alleged invention of Brooks or differentiate it from the prior art.

Hence, the lower court's bare conclusion of invention without finding any subsidiary or primary facts on the basis of which such finding is made can have little or no weight,* and certainly is not binding on the appellate court as petitioner now argues.

The only finding made that can be said to bear on the issue of invention was that the prior art cleaners were not "designed by their maker, nor . . . adapted, nor actually used for the performance of the functions performed by the apparatus of the patent in suit" ("Findings of Fact" 11, 13, 14, Pet. pp. 33, 34). By this the lower court meant "cleaning lint cotton as it comes from the gin" (see Finding 12, last line, Pet. p. 33). But this is simply a finding that the prior art cotton cleaners, mostly designed for textile mill or beginning cleaning, were not designed for use in a gin house between gin and bale press. And no one,

*It is a grave question whether the lower court complied with the requirements of Rule 52(a) of the Federal Rules of Civil Procedure in its finding as to invention. As this Court stated in *Kelley v. Everglades Drainage District*, 319 U.S. 415, 420 (1943): ". . . there must be findings, in such detail and exactness as the nature of the case permits, of subsidiary facts on which the ultimate conclusion . . . can rationally be predicated." General conclusions—such as a finding of invention—are conclusions of law and not binding on appeal. In *Hycom Mfg. Co. v. H. Koch & Sons*, 219 F. 2d 353, 356 (9 Cir. 1955), the court found that findings like those of the lower court in this case were "entirely inadequate," saying that the counsel "seem to have presented the court with formalistic pronouncements of 'ultimate fact,' which are in effect conclusions. . . . The court must find facts which support three essentials: novelty, utility and invention. Mere conclusions in order to hold a patent valid, such as are contained in this record, are of no avail. No opinion was before this Court. There is indication neither why the trial judge thought the device was an invention nor why the patented article was differentiated from the prior art." The case at bar is strikingly parallel, even to the absence of an opinion and the fact that the "findings" were prepared by prevailing counsel.

least of all the Court of Appeals, questioned this. The uses contemplated in the references were for cleaning in the mill, with lower volume and capacity than is required in cleaning the larger output of a gin. But the question, on invention, was whether it met the statutory requirement to take the old cotton cleaner, standard for decades in textile mills, and use it in a gin house, without change except for such increase in size and capacity as may be desired. As to that, the single finding of the lower court signifies nothing.

Thus the Court of Appeals disregarded no finding of fact, in the sense of Federal Rules of Civil Procedure, 52(a), which has reference to primary or subsidiary facts as distinct from ultimate facts which amount to conclusions of law. The ultimate decision of whether what was indisputably done involved invention over a prior art of undisputed teaching (all as in this case) is one on which a reviewing court is clearly empowered to impose the statutory standard.

Petitioner's "Questions Presented" (Pet. p. 2) imply that the Court of Appeals disregarded "findings of fact." This did not happen. The Court of Appeals disregarded only the conclusion of law that there was invention.

The fallacy of the petition is that disagreement between the Court of Appeals and the District Court is not on the facts but on the basic question of invention, as is apparent from the opinion of the appellate court.

Though petitioner sets forth three numbered paragraphs of "Questions Presented" (Pet. pp. 2-3), these state and restate what is really a single question: whether Federal Rules of Civil Procedure, 52(a), leaves room for a reviewing court to reverse a lower court conclusion of invention. But the answer is so clear that this question is not a substantial one.

A trial court's conclusion on the all important question of invention incorporated into "Findings of Fact" does not render that conclusion immune to appellate review or correction, as petitioner would have it. The cases are legion in which the appellate courts and this Court have decided the question of patentable invention in disregard of the conclusion thereon reached below.* One of the innumerable cases of this Court showing the propriety of thus overruling the trier of facts on the issue of patentable invention is the familiar *Atlantic & Pacific* case, 340 U.S. 147, in which this Court reversed the concurrent findings of the two lower courts that the subject matter of the patent was inventive, and hence not obvious. In disposing of the argument that this Court was bound by the concurrent findings below, this Court, through Mr. Justice Jackson, said (p. 153):

> "It is urged, however, that concurrence of two courts below, in holding the patent claims valid, concludes this Court. A recent restatement of the 'two-court rule' reads, 'A court of law, such as this Court is, rather than a court for correction of errors in fact find-

*See, for instance, *Mahn* v. *Harwood*, 112 U.S. 354, 358 (1884); *Little Mule Corp.* v. *The Lug-All Co.*, 254 F. 2d 268 (C.A. 5, 1958), cert. den. 358 U.S. 838; *Fritz W. Glitsch & Sons* v. *Wyatt Metal & Boiler Works*, 224 F. 2d 331, 335 (C.A. 5, 1955); *New Products Corp.* v. *Outboard, Marine & Mfg. Co.*, 263 F. 2d 521 (C.A. 7, 1959); *Rohr Aircraft Corp.* v. *Rubber Teck, Inc.*, — F. 2d —, 121 U.S.P.Q. 241, 245 (C.A. 9, 1959); *Kwikset Locks, Inc.*, v. *Hillgren*, 210 F. 2d 483, 488 (C.A. 9, 1954), cert. den. 347 U.S. 989; *Blish, Mize & Silliman Hardware Co.* v. *Time Saver Tools, Inc.*, 236 F. 2d 913, 916 (C.A. 10, 1956), cert. den. 352 U.S. 1004. In *Packwood* v. *Briggs & Stratton Corp.*, 195 F. 2d 971 (C.A. 3, 1952), cert. den. 344 U.S. 844; and *Alemite Co.* v. *Jiffy Lubricator Co.*, 176 F. 2d 444 (C.A. 8, 1949), cert. den. 339 U.S. 942, even *jury* findings of invention were overruled on appeal where the patents did not measure up to the requisite standard of invention.

ing, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error.' *Graver Tank Co.* v. *Linde Co.*, 336 U.S. 271, 275. The questions of general importance considered here are not contingent upon resolving conflicting testimony, for the facts are little in dispute. *We set aside no finding of fact as to invention,** for none has been made except as to the extension of the counter, which cannot stand as a matter of law. The defect that we find in this judgment is that a standard of invention appears to have been used that is less exacting than that required where a combination is made up entirely of old components. It is on this ground that the judgment below is reversed."

It was on this same ground that the Court of Appeals reversed the judgment of the District Court in the instant case.

More recently, in *Crest Specialty* v. *Trager*, 341 U.S. 912, 913, this Court, in a *per curiam* opinion, reversed the Court of Appeals of the Seventh Circuit, which had affirmed the trial court's judgment of validity. The Court of Appeals had affirmed the lower court's "findings" on the assumption that it was bound by them (184 F. 2d 577, 578-579).

Petitioner quotes from the *Graver Tank* case and cites the reference to that case in the *Atlantic & Pacific* case. In *Graver* the trial judge had made a careful analysis of the claimed invention and the prior art, had visited laboratories to observe demonstrations of the art as taught by the patent, and "of various stages of the prior art," and had made specific findings with respect thereto. It was findings of this character which this Court [illegible] should not

*Emphasis ours.

be reversed on appeal unless "clearly erroneous." In the case at bar there are no such findings as were involved in the *Graver* case. The findings as to the prior art on which the appellate court found invalidity in the present case were first made by that court and are not in dispute. And in the *Graver* case the court said: ". . . the ultimate question of patentability is one of meeting the requirements of the statute . . ." (336 U.S. 271, 275).

While the "Questions Presented" indicate that credibility and conflicting testimony and demonstrations as to primary facts were involved on the issue of invention, as in the *Graver* case, this is just not so. Petitioner points out not a single such fact as to which there was any conflict, and there is not one. The demonstrations that were had before the lower court were of plaintiff's and defendant's commercial machines and wholly concerned with the issue of infringement. The lower court also viewed some movies directed to the issue of infringement and one movie (Ex. X, introduced R. 233) of the operation of certain feed rolls feeding to defendant's accused cleaner (R. pp. 225-233; 243). This was not a demonstration of any prior art machine as petitioner's expert agreed (R. p. 574), and there was no dispute as to what this movie showed. No dispute as to the import of any of this material, on the issue of invention, was resolved by the lower court or disregarded by the Court of Appeals, as petitioner asserts (p. 12) in citing *Graver Tank* as to "conflicting testimony."

Finally, petitioner argues (Pet. p. 9) that this petition should be granted because the manufacture of "lint cotton cleaning machinery sold in competition" with petitioner (Pet. p. 38)—that is, manufacture of cleaners for gin house use—"is concentrated in the Fifth Circuit," making "improbable" any prospect of petitioner securing a conflict of decision on validity.

In the *Schriber-Schroth* and *Muncie* cases, cited by petitioner (p. 9), the patent had been held *valid* and further test was unlikely because all manufacture was concentrated in the one circuit. If the patent was indeed invalid—as this Court found when it took these cases—such patent might run its life without possibility of challenge. It was in the public interest that an invalid patent should not thus hamper progress in the art involved and the public should not have to pay tribute to an invalid patent for its life. In the present case, however, the patent has been held *invalid*, and petitioner is not foreclosed from a further test of the validity of its patent. For users of competitors' ginning machinery with cleaners are scattered throughout North and South Carolina, Arkansas, Arizona and California, in the Fourth, Eighth and Ninth Circuits, wherever cotton is raised in quantity. Such users of alleged infringing machinery of a competitor's make can therefore be sued in circuits other than the Fifth to further test the validity of the Brooks patent, if petitioner so desires.

There being no conflict with the decision of another Court of Appeals on the same matter, no federal question of any public importance nor any departure from the accepted and usual course of judicial proceedings presented here, no basis exists for the grant of a writ of certiorari, under the established rules of this Court.

The petition should be denied.

Respectfully submitted,

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